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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/015,738	12/12/2001	Howard W. Lutnick	CF-030	3474
64558	7590	06/14/2007		
FISH & NEAVE IP GROUP ROPES & GRAY LLP 1211 AVENUE OF THE AMERICAS NEW YORK, NY 10036-8704			EXAMINER ZECHER, MICHAEL R	
			ART UNIT 3609	PAPER NUMBER
			MAIL DATE 06/14/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/015,738

**Applicant(s)**

LUTNICK ET AL.

**Examiner**

Michael R. Zecher

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 4/29/2003, 6/30/2003.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_.
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. The following is a non-final, first Office action on the merits. Claims 1-23 are pending.

#### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. **Claims 1-23** are rejected under 35 U.S.C. 102(b) as being anticipated by Shepherd (U.S. 5,970,479).

**As per claim 1**, Shepherd teaches a method for trading of intangible assets in a computer-based futures exchange system (See abstract, column 1, lines 65-66, and column 2, lines 30-31, which discuss intangible assets such as associated intellectual property (e.g. patents) and future contracts), comprising:

accessing a listing of a plurality of intangible asset futures contracts (See figure 12, #1320, which illustrates a PDEAL list that contains products, such as risk management contracts, individual and portfolio, that can be obtained);

selecting an intangible asset futures contract from the listing (See figure 12 which illustrates the process of matching viable contract, individual and portfolio, orders);

viewing trading status of the selected intangible asset future contract (See figure 18, #480, which illustrates a trade price data file that contains updated information on contracts, individual and portfolio).

**As per claims 2 & 3**, Shepherd teaches executing a trade of intangible asset futures contracts in a future contract fund and executing a trade of the intangible asset future contract (See figure 27, and column 55, lines 55-59, which illustrates confirming the contract trading process and discusses offering contracts for trade individually or as a portfolio—category grouping).

**As per claims 4 & 5**, Shepherd teaches viewing the intangible asset futures contract's terms of the contract and viewing the intangible asset futures contract funds terms of the contract (See figure 18, #320, which illustrates an ADMIN data file containing full details of the contract, individual or portfolio, each sponsor is endorsing).

**As per claims 6 & 7**, Shepherd teaches providing data related to the intangible asset futures contract and providing data related to the intangible asset future contracts fund (See figure 18, #510 & #520, which illustrates information and history data files concerning respective contracts, individual or portfolio).

**As per claims 8 & 9**, Shepherd teaches utilizing analysis tools related to the intangible asset futures contract and utilizing analysis tools related to the intangible asset futures contract fund (See figure 19 which illustrates analyzing and processing various trades concerning contracts, individual or portfolio).

**As per claims 10 & 13**, Shepherd teaches a system for trading of intangible assets (See abstract, column 1, lines 65-66, and column 2, lines 30-31, which discuss intangible assets such as associated intellectual property rights (e.g. patents) and future contracts ) comprising an equipment of a future exchange system (See figure 1 which illustrates a processing unit that can be constituted by one or more data processing

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apparatus) configured to access a listing of a plurality of intangible asset future contracts and future contracts funds (See figure 12, #1320, which illustrates a PDEAL list that contains products, such as risk management contracts, individual and portfolio, that can be obtained), select an intangible asset futures contract and futures contract fund from the listing (See figure 12 which illustrates the process of matching viable contract, individual and portfolio, orders), and view the trading status of the selected intangible asset futures contract and futures contract fund (See figure 18, #480, which illustrates a trade price data file that contains updated information on contracts, individual and portfolio).

**Claims 11-12, & 14-18** recite equivalent limitations to claims 3, 2, 4, & 6-9 respectively, and are therefore rejected using the same art and rationale set forth above.

**As per claims 19 & 20**, Shepherd teaches wherein the equipment of the futures exchange system is configured to execute the trade of the intangible asset futures contract and futures contract fund by matching of a buy offer and a sell offer (See figure 19, #1340 & #1390, which illustrate order matching and matched order confirmation of contracts, individual or portfolio).

**As per claims 21 & 22**, Shepherd teaches a system for trading of intangible asset futures contracts in a computer-based future exchange system (See abstract, column 1, lines 65-66, and column 2, lines 30-31, which discuss intangible assets such as associated intellectual property (e.g. patents) and future contracts), wherein the equipment of the futures exchange system (See figure 1 which illustrates a processing

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unit that can be constituted by one or more data processing apparatus) offers standard intangible asset offer terms for transactions and futures contract terms (See figure 18 which illustrates data files containing standard offer terms such as sell price, trade price, sell limit, trade limit).

**As per claim 23**, Shepherd teaches wherein the standard intangible asset futures contract terms are categorized based on categories of intangible asset future contracts (See figure 18 and column 55, lines 55-59, which illustrates data files containing standard offer terms such as sell price, trade price, sell limit, trade limit; and, furthermore, discusses offering contracts for trade individually or as a portfolio—category grouping).

### ***Conclusion***

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

May (2002/0138390) discloses systems, methods and computer program products for subject-based addressing in an electronic trading system.

Lancaster (U.S. 6,876,982) discloses a universal contract exchange.

Vinarsky (U.S. 6,390,472) discloses a pseudo-commodities interactive futures trading game.

Push (U.S. 2002/0035531) discloses a common margin settlement vehicle and method of margining exchange-traded futures contracts.

May (U.S. 2003/00093360) discloses systems, methods and computer program products for electronic trading of financial instruments.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael R. Zecher whose telephone number is 571-270-3032. The examiner can normally be reached on M-F 7:30-5:00 alt. Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynda Jasmin can be reached on 571-270-3033. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MRZ

  
LYNDA JASMIN  
SUPERVISORY PATENT EXAMINER